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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,426	05/18/2001	Chi-Thanh Dang	109445	3709
25944	7590	09/17/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320				SMITH, PETER J
ART UNIT		PAPER NUMBER		
		2176		

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/859,426	DANG ET AL.
Examiner	Art Unit	
Peter J Smith	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 18 May 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-21 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 19 March 2002 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.

## DETAILED ACTION

1. This action is responsive to communications: application filed on 5/18/2001.
2. Claims 1-21 are pending in the case. Claims 1, 6, 11, 16, and 21 are independent claims.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 21 is directed towards a “carrier wave” which is non-statutory because it does not fit into any of the three statutory product classes because it is non-physical. See MPEP §2106:

For the purposes of a 35 U.S.C. 101 analysis, it is of little relevance whether the claim is directed to a machine or a process. The legal principles are the same. AT &T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1357, 50 USPQ2d 1447, 1451 (Fed. Cir. 1999).

(a) Statutory Product Claims

Products may be either machines, manufactures, or compositions of matter.

A *machine* is “a concrete thing, consisting of parts or of certain devices and combinations of devices.” *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

A *manufacture* is “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties or combinations, whether by hand labor or by machinery.” *Chakrabarty*, 447 U.S. at 308, 206 USPQ at 196-97 (quoting *American Fruit Growers, Inc. v. Brogden Co.*, 283 U.S. 1, 11 (1931)).

A *composition of matter* is “a composition of two or more substances [or] . . . a[] composite article, whether [it] be the result[] of chemical union, or of mechanical mixture, or whether . . . [it] be [a] gas[], fluid[], powder[], or solid[].” *Id.* at 308, 206 USPQ at 197 (quoting *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 SPQ 265, 266 (D.D.C. 1957), aff’d per curiam, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958)).

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760. Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim

does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

A claim limited to a machine or manufacture, which has a practical application in the technological arts, is statutory. In most cases, a claim to a specific machine or manufacture will have a practical application in the technological arts. See *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 ("the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. This is not a disembodied mathematical concept which may be characterized as an abstract idea,' but rather a specific machine to produce a useful, concrete, and tangible result."); and *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601 ("the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces a useful, concrete and tangible result' – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades."). Also see *AT & T*, 172 F.3d at 1358, 50 USPQ2d at 1452 (Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held patentable subject matter because the process used the algorithm to produce a useful, concrete, tangible result without preempting other uses of the mathematical principle.).

The three statutory product classes have traditionally required physical structure or matter. The claimed carrier wave has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine. The claimed carrier wave is not matter, but a form of energy, and therefore is not a composition of matter. A manufacture can be an article produced from raw or prepared materials by manipulating the raw or prepared materials. A manufacture is also defined as the residual class of product. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. Thus, the Examiner concludes that the claimed carrier wave is not one of the three statutory product classes.

5. Additionally, independent claim 21 is directed towards a "control program usable for managing dynamic translation to a device for executing the control program" to perform instructions. As presently drafted, the claim reads on a computer program per se, which does not

constitute statutory subject matter as prescribed under 35 USC §101. Applicant could easily render the claimed invention statutory by amending the preamble to recite “A control program stored on a computer readable medium”. The language in the preamble “A carrier wave encoded” with the control program does not render the claim statutory because a carrier wave is not a computer readable medium.

The language in the preamble, “usable for managing dynamic translation to a device for executing the control program” does not render the claimed invention statutory because it in effect constitutes intended use. See MPEP §2106:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

(A) statements of intended use or field of use,

Therefore, the intended use language does not limit the claim, and cannot be given patentable weight or a cause for the preamble to be statutory. For these two reasons set forth in this and the preceding paragraph 4, independent claim 21 is found by the Examiner to be non-statutory under 35 U.S.C. 101.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**7. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso et al., US 6,421,733 B1 filed 9/8/1997.**

**Regarding independent claim 1,** Tso discloses an identity storage that stores identity information associated with a client and user in col. 6 line 64 – col. 8 line 9. The characteristics and preferences of users, content providers and servers are all stored in identity storages which are accessed by the transcoding server to perform dynamic customizations on requested content. Tso discloses a client and user determining circuit that determines a sending client and a user of a received request for first information from a first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses an input/output circuit that requests and receives the first information from the first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses a merging circuit that determines the merged content portion based on the received first information and at least one an identity, at least one identity associated with one of the determined client and the user in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55.

**Regarding dependent claim 2,** Tso discloses wherein the identity storage comprises identity content element storage and identity presentation information storage in col. 6 line 64 – col. 8 line 9. The characteristics and preferences of users, content providers and servers are all stored in identity storages which are accessed by the transcoding server to perform dynamic customizations on requested content.

**Regarding dependent claim 3,** Tso discloses wherein the client and user determining circuit determines at least one of a client identification and a user identification based on at least

one of internet protocol address information, session identifier information, name pairs and value pairs in col. 6 line 64 – col. 8 line 9.

**Regarding dependent claim 4**, Tso discloses wherein the merged content portions are stored using at least one of an electronic medium, a printed medium, and a paper medium in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

**Regarding dependent claim 5**, Tso discloses wherein the merged content portions are at least one of an electronic text, a printed text, an audio book and a video book in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

**Regarding independent claim 6**, Tso discloses receiving a first information request having a first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses determining at least one of a client and a user associated with the first information request in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses receiving the requested first information from the first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses determining identity information from the stored identity information based on the determined client and user information in col. 6 line 64 – col. 8 line 9. Tso discloses determining a merged content portion based on the first information and the determined identity information in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55.

**Regarding dependent claim 7**, Tso discloses wherein the stored identity information comprises at least one of identity content element information and identity presentation

information in col. 6 line 64 – col. 8 line 9. The characteristics and preferences of users, content providers and servers are all stored in identity storages which are accessed by the transcoding server to perform dynamic customizations on requested content.

**Regarding dependent claim 8**, Tso discloses wherein the client and user information is determined based on at least one of internet protocol address information, session identifier information, name pairs and value pairs in col. 6 line 64 – col. 8 line 9.

**Regarding dependent claim 9**, Tso discloses wherein determining the merged content portions produces at least one of an interactive text, a printed text, an audio book and a video book in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

**Regarding dependent claim 10**, Tso discloses wherein the merged content portions are stored on at least one of electronic media, printed media, and a paper media in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

**Regarding independent claim 11**, Tso discloses receiving a first information request having a first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses determining the client and user associated with the first information request in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses receiving the first information from the first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses determining identity information from the stored identity information based on the determined client and user information in col. 6 line 64 – col. 8 line 9.

Tso discloses determining a merged content portion based on the first information and the determined identity information in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55.

**Regarding dependent claim 12**, Tso discloses wherein the stored identity information comprises at least one of identity content element information and identity presentation information in col. 6 line 64 – col. 8 line 9. The characteristics and preferences of users, content providers and servers are all stored in identity storages which are accessed by the transcoding server to perform dynamic customizations on requested content.

**Regarding dependent claim 13**, Tso discloses wherein the client and user is determined based on at least one of internet protocol address information, session identifier information, name pairs and value pairs in col. 6 line 64 – col. 8 line 9.

**Regarding dependent claim 14**, Tso discloses wherein determining the merged content portions produces at least one of an interactive text, a printed text, an audio book and a video book in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

**Regarding dependent claim 15**, Tso discloses wherein the merged content portions are stored on at least one of electronic media, printed media, and a paper media in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

**Regarding independent claim 16**, Tso discloses an identity storage that stores identity information associated with a client and user in col. 6 line 64 – col. 8 line 9. The characteristics

and preferences of users, content providers and servers are all stored in identity storages which are accessed by the transcoding server to perform dynamic customizations on requested content. Tso discloses a client and user determining circuit for determining the sending client and user of a received request for first information from a first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses an input/output circuit for requesting and receiving the first information signal from the first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses a merging circuit for determining a merged content portion based on the received first information signal and an identity associated with the determined client and user in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55.

**Regarding dependent claim 17**, Tso discloses wherein the identity storage comprises identity content element storage and identity presentation information storage in col. 6 line 64 – col. 8 line 9. The characteristics and preferences of users, content providers and servers are all stored in identity storages which are accessed by the transcoding server to perform dynamic customizations on requested content.

**Regarding dependent claim 18**, Tso discloses wherein the client and user determining circuit determines at least one of a client identification and a user identification based on at least one of internet protocol address information, session identifier information, name pairs and value pairs in col. 6 line 64 – col. 8 line 9.

**Regarding dependent claim 19**, Tso discloses wherein the merged content portions are stored on at least one of an electronic media, a printed media, and a paper media in fig. 3, 5, 9,

col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

**Regarding dependent claim 20**, Tso discloses wherein the merged content portions are at least one of an interactive electronic text, a printed text, an audio book and a video book in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

**Regarding independent claim 21**, Tso discloses receiving a first information request having a first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses determining at least one of a client and a user associated with the first information request in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses receiving the requested first information from the first information provider in fig. 3, 5, 7-9, col. 2 lines 9-18, and col. 2 line 44 – col. 3 line 6. Tso discloses determining identity information from the stored identity information based on the determined client and user information in col. 6 line 64 – col. 8 line 9. Tso discloses determining a merged content portion based on the first information and the determined identity information in fig. 3, 5, 9, col. 2 lines 44-55, col. 6 line 64 – col. 8 line 9, and col. 14 lines 47-55.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Broman et al., US 6,751,778 B1 filed 5/3/1999 discloses dynamically rendering information pages. Hind et al., US 6,715,129 B1 filed 10/13/1999 discloses transcoding the content of a document requested by a client, in order to tailor the output of the document according to application-specific characteristics. Quatrano et al., US 6,675,216 B1 filed 7/6/1999 discloses a system in which two or more parties such as a user and an agent, can share dynamic content generated by a web site. Cuomo et al., US 6,286,043 B1 filed 8/26/1998 discloses collecting information about user behavior in the presence of dynamic page content. Roberts et al., US 6,101,486 filed 4/20/1998 discloses gathering and storing customer profile data and selecting dynamic content messages from company marketing material in accordance with the profile data and used to provide a customized webpage to the customer.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931 (571-272-4101 after 10/20/2004). The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792 (571-272-4090 after 10/20/2004). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PJS  
September 2, 2004



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SUPERVISORY PATENT EXAMINER